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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,224

11/17/2004

Shinro Oyama

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EXAMINER

KASHNIKOW, ERIK

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,224	<b>Applicant(s)</b> OYAMA ET AL.	
	<b>Examiner</b> ERIK KASHNIKOW	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-13, 15, 17, 19, 21, 22, 28, 30-32, 34, 36-38, 40, 41, 43-45, 47-49, 51-53, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/01/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-6,8-13,15,17,19,21,22,28,30-32,34,36-38,40,41,43-45,47-49,51-53,55 and 56.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2, 19 and 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 5 of copending Application No. 10/562,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims teach articles comprising the same materials (polytetrafluoroethylene) and having the same thickness (20  $\mu\text{m}$ ), and therefore the physical/mechanical properties would be inherent. While the copending claim does not disclose a rolling number greater of 2, they do teach that the film is a tubular film, and a well known method for making a tubular article is to wind the film in a tubular shape, and winding the film so that it has a rolling number greater than

one is not patentably distinct. The copending claim is also silent regarding a stretching step, however the copending claim teaches properties such as tensile stresses at a set elongation. One of ordinary skill in the art at the time of the invention would recognize that an elongation means that the film has been stretched, and since the copending application teaches that the film be stretched to measure this property it would be obvious to one of ordinary skill in the art at the time of the invention that the film has undergone a stretching step.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 2, 19 and 34 directed to an invention not patentably distinct from claims 1, 4 and 5 of commonly assigned 10/562,447. Specifically, see the above paragraph for a detailed description of the rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/566,447, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, 9, 15, 17, 34, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollenbaugh et al. (5,281,475).

5. Hollenbaugh et al. teach a novel continuous polytetrafluoroethylene fiber having a substantially round profile (column 1 lines 6-8).

6. In regards to claim 1 Hollenbaugh et al. teach that the invention is directed to articles, such as tubes, and are made from polytetrafluoroethylene (column 2 lines 65-68). Hollenbaugh et al. teach that the articles have tensile strengths (called stress at maximum load see column 7 lines 23-25) of 100,000 KPa (or 100,000 N/mm<sup>2</sup>) (column 8 lines 27-30). While Hollenbaugh et al. are silent regarding rolling numbers, the figures show embodiments wherein the rolling number is greater than 2 (figure 3). Hollenbaugh et al. also teach that the sheet is subjected to a stretching step (column 3 lines 9-14).

7. In regards to claim 2 Hollenbaugh et al. teach an embodiment wherein the sheet is 0.01mm thick which relates to 10 $\mu$ m (example 5).
8. In regards to claims 4, 5, 15 and 17 Hollenbaugh et al. teach an article of their invention with a diameter of 55  $\mu$ m (column 10 lines 10-11). This would give a maximum wall thickness of 27.5  $\mu$ m.
9. In regards to claims 9, 34, 36 and 37 Hollenbaugh et al. teach that the inner surface of the PTFE sheet is subjected to a heating treatment as it passes over the drums, to increase the adhesive properties of the sheet (column 4 lines 21-43).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 8, 10-13, 19, 21, 22, 28, 30-32, 38, 40, 41, 43-45, 47-49, 51-53, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenbaugh et al. (5,281,475) in view of Kotani et al. (US 5,766,751).
11. As stated above, Hollenbaugh et al. teach PTFE films and tubes made from PTFE films, however they are silent regarding the films being used as components of a fixing belt or a fixing roll as well as percentage of light transmittance and surface roughness

12. In regards to claims 8, 28 and 30-32 Kotani et al. teach PTFE included as a base member (column 16 line 1-25) for use as packaging material (column 1 line 16-23). Kotani et al. teach that the entire laminate structure has a light transmittance of at least 80% (column 10 lines 61-67).

13. In regards to claims 10-13, 41, 43-45, 47-49, 51, 52 and 56, while Hollenbaugh et al. teach that the film is used to make articles of manufacture which are rods or tubes made of the PTFE film (column 2 lines 65-68), there is no disclosure that the PTFE film is a component of a fixing roll or belt as presently claimed. Applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

14. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. as a component of a fixing roll, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art



Hollenbaugh et al. and further that the prior art structure which is a tubular film identical to that set forth in the present claims is capable of performing the recited purpose or intended use. All other limitations of the claims have been taught by Hollenbaugh et al. and Kotani et al. as discussed above.

15. In regards to claims 6, 19, 20, 21 and 22 absent a showing of criticality with respect to roughness (a result effective variable), it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust the roughness through routine experimentation in order to achieve an effective filter or packaging material. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

16. In regards to claims 32, 38, 45 and 53, all further limitations have been taught by Hollenbaugh et al. and Kotani et al. as shown above.

17. One of ordinary skill in the art at the time of the invention would be motivated to use the film of Kotani to modify the packaging film of Hollenbaugh et al. because the packaging film with excellent gas barrier property of Kotani et al. (column 1 line 11) would benefit from the film of Hollenbaugh et al. which offers a high tensile strength as well as resiliency (column 6 line 47-54).

### ***Response to Arguments***

Applicant's arguments with respect to all claims that are currently pending have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Of the 3 X references submitted in various search reports by Applicants', US 2003/0113143 teaches PTFE films used as outer layers for fixing apparatus, as well as the smoothness of the film. The Japanese Patent document JP 2000-3100 teaches a transfer belt which exhibits tensile properties similar to that of the instant application. The catalog search from C.S. Hyde Company for PTFE Skived tape with tensile strengths around Applicants.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIK KASHNIKOW whose telephone number is (571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikow  
Examiner  
Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794

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